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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,479	09/04/2003	Jonathan Helitzer	Hartford-Y1779-00002	8693
45722	7590	03/03/2006	EXAMINER	
PLEVY & HOWARD, P.C.			PASS, NATALIE	
P.O. BOX 226			ART UNIT	
FORT WASHINGTON, PA 19034			PAPER NUMBER	

3626

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,479

Applicant(s)

HELITZER ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/4/03, 5/6/04, 2/15/05, 10/25/05, 11/7/05.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 7-11, 14 and 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 6, 12, 13, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/24/05</u> | 6) <input type="checkbox"/> Other: _____ |

Notice to Applicant

1. This communication is in response to the application filed 4 September 2003, the Preliminary Amendments filed 6 May 2004 and 15 February 2005, the Response to Restriction Requirement filed 25 October 2005 and the telephone conversation of 7 November 2005 with Attorney Jonathan M. Darcy. Claims 1-22 are pending. Claims 5-6, 12-13, 15-16 have been elected without traverse. Claims 1-4, 7-11, 14, 17-22 are withdrawn from further consideration by the examiner as being drawn to a non-elected invention. The IDS filed 24 March 2005 has been entered and considered.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-4, drawn to underwriting insurance and providing insurance policies, classified in class 705, subclass 4.
 - II. Claims 5-6, 12-13, 15-16, drawn to maintaining and utilizing databases, classified in class 707, subclass 104.1.
 - III. Claims 7, 17-19, 20-21, and 22, drawn to classifying of input data, classified in class 706, subclass 20.
 - IV. Claims 8-9, 10-11, and 14, drawn to processing information using expert systems, classified in class 706, subclass 60.

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3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II and III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I has separate utility such as writing an insurance policy or processing an insurance claim, and Invention II has separate utility such as specific applications of database schema and data structures to commercial fields. Invention III has separate utility such as using the system to categorize or identify input data. Invention IV has separate utility such as to applying a reasoning technique using an interface to a knowledge base or a knowledge processing system. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. During a telephone conversation with Jonathan M. Darcy, on 7 November 2005, a provisional election was made without traverse to prosecute the invention of Group II, claims 5-6, 12-13, 15-16. Affirmation of this election must be made by applicant in replying to this Office

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action. Claims 1-4, 7-11, 14, 17-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 5 recites "the risk reduction" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 5-6, 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Prendergast et al., U.S. Patent Number 5, 842, 148.

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(A) As per claim 5, Prendergast teaches a method for underwriting insurance by taking into account technologies that militate against loss comprising the steps of:

maintaining a database identifying a plurality of technologies that reduce risk of loss to an associated building structure (Prendergast; column 2, lines 29-34);

identifying a building structure comparable to the associated building structure, that requires insurance (Prendergast; column 2, line 62 to column 3, line 5, column 3, lines 23-29);

calculating the risk of loss related to the building structure (Prendergast; column 5, lines 24-34, 46-50); and

accounting for the risk reduction resulting from incorporation of at least one technology into the building structure (Prendergast; column 6, line 58 to column 7, line 2).

giving "lower insurance rates" to "structures getting a favorable rating" reads on "creating an insurance policy for the structure based upon the incorporated risk reduction technology" (Prendergast; column 6, line 58 to column 7, line 2),

(B) As per claim 6, Prendergast teaches a method as analyzed and discussed in claim 5 above including the further step of "collect[ing] structural characteristics data" (reads on "polling the insured interest to determine its compliance with incorporation of at least one technology into the building structure") (Prendergast; column 2, lines 26-39).

(C) System claim 12 differs from claim 5, in that claim 5 contains a method recited as a series of function steps whereas claim 12 contains features recited in a "means plus function" format. As the method of step claim 5 has been shown to be disclosed or obvious by the

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teachings of Prendergast, it is readily apparent that the “means” to accomplish those method steps is obvious in view of the prior art. As such, the limitations recited in claim 12 are rejected for the same reasons given for method claim 5 and incorporated herein.

(D) As per claim 13, Prendergast teaches a system as analyzed and discussed in claim 12 above, wherein the output means is a device or computer wherein “[t]he precise substance and format of report 40 can be tailored to fit specific needs of any particular market segment or audience” (reads on “to print an insurance policy based on an insurable interest”) (Prendergast; Abstract, column 7, lines 30-32).

11. Claims 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by DeTore et al., U.S. Patent Number 4, 975, 840.

(A) As per claim 15, DeTore teaches a method of underwriting insurance comprising the steps of:

maintaining a data base identifying risk mitigation technology and corresponding loss mitigation values (DeTore; column 1, line 59 to column 2, line 30); and

scanning periodically an insurable interest to identify sensors and corresponding sensor data associated with risk mitigation technology (DeTore; column 15, lines 6-17, columns 25-26, paragraph 4); and

comparing sensor data to the risk mitigation technology and corresponding loss mitigation values (DeTore; column 15, line 60 to column 16, line 7, column 17, lines 35-60);

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and

controlling a computer or printing device to “[u]nderwrite the case” (reads on “print an insurance policy”) (DeTore; column 9, lines 37-42column 13, lines 25-26).

(E) System claim 16 differs from claim 15 in that it recites in the preamble “[a] system for identifying matches between risk mitigation technology installed at an insurable interest and a risk mitigation technology listed in an insurance policy,” rather than “[a] method of underwriting insurance.”

As per the preamble of system claim 16, DeTore teaches a system for “correlating” (reads on “identifying matches” between risk mitigation technology installed at an insurable interest and a risk mitigation technology listed in an insurance policy (DeTore; Abstract, column 1, line 59 to column 2, line 30, columns 25-26, paragraph 4).

The remainder of system claim 16 differs from claim 15, in that claim 15 contains a method recited as a series of function steps whereas claim 16 contains features recited in a “means plus function” format. As the method of step claim 15 has been shown to be disclosed or obvious by the teachings of DeTore, it is readily apparent that the “means” to accomplish those method steps is obvious in view of the prior art. As such, the remaining limitations recited in claim 16 are rejected for the same reasons given for method claim 15 and incorporated herein.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references Lloyd et al., U.S. Patent Number 5, 950, 150,

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Bonissone et al., U.S. Patent Application Publication Number 2003/0187702, and Lloyd et al., U.S. Patent Number 5, 680, 329 teach the environment of reducing insurance risk.

13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the communication
and do NOT sign the communication.

After Final communications should be labeled "Box AF."

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

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15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

November 23, 2005



JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER